

REMARKS

This paper is filed in response to the office action mailed on May 20, 2004. Claims 2-16, 18, 23-28, 40-51, 53-56, 58-63, 65-68 and 70 have been restricted and therefore at least temporarily have been withdrawn from consideration. Claims 1, 17, 19-22, 39, 52, 57, 62-64 and 69 stand rejected. Claims 1, 19-20, 52 and 64 have been amended; no claims have been canceled; therefore, claims 1, 17, 19-22, 39, 52, 57, 62-64 and 69 remain pending.

Applicants respectfully submit that the multiple-way restriction requirement imposed in the office action remains a significant burden on the applicant. In view of the clear allowability of amended independent claims 1, 20, 52 and 64, applicants respectfully submit that the species disclosed in Figs. 3-10, in addition to the specie of Figs. 1-2, are covered by independent claims by 1, 20, 52 and 64 and therefore these species should be re-entered in this application. Further, applicants respectfully submit that the re-entry of the species disclosed in Figs. 3-10 also warrants the re-entry of claims 2-16, 18, 23-38, 40, 53-56, 58, 65-68 and 70. Further, applicants respectfully reserve the right to amend independent method claims 41, 59 and 71 to render them allowable over the art of record thereby warranting the re-entry of the method claims as well.

With respect to the rejections based upon the prior art, pending claims 1, 17, 19-22, 39, 52, 57, 64 and 69 all stand rejected under 35 USC § 102 as being anticipated by U.S. Patent No. 6,524,300 ("Meglin"), U.S. Patent No. 5,743,876 ("Swanson") or U.S. Patent No. 6,152,909 ("Bagaoisan").

In response, independent claims 1, 20, 52 and 64 all require the at least one circumferential slit that provides the increased flexibility to the second section and which extends at least partially through and circumferentially around the tubular wall. This element is clearly disclosed by the partial circumferential slits 35 of Figs. 1-2 as well as the spiral circumferential slits 35a, 35b, 35c, 35d and 35e of Figs. 3-10 thereby warranting the re-entry of the species of Figs. 3-10.

Applicants respectfully submit that all anticipation rejections fail to meet the criteria set forth by the MPEP and the relevant case law. Specifically, under MPEP § 2131,

[t]o anticipate a claim, the reference must teach every element of the claim. A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Citing, *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

None of the prior teaches or suggests a circumferentially extending slit in a tubular wall of a hypotube to provide increased flexibility to a section of the tube disposed between a solid proximal proximal portion of the tube and a distal stinger.

Specifically, the Meglin reference does not teach or suggest any circumferentially extending slits. Instead, Meglin is directed toward an infusion device with differently spaced axial openings or axial slots in the tube. Meglin, in fact, teaches away from the present invention as a proximal section 101 disposed upstream of the more distal section 102 includes more slots 104 than the section 102. Therefore, the Meglin device teaches a tube that has an increased flexibility at a point spaced upstream from its distal section or distal end.

In contrast, the amended independent claims require the first section to include at least one circumferential slit which is disposed between the main section the second section or stinger. Thus, with the presently amended independent claims, the flexibility of the device increases as it goes from the main section, to the first section with the slit and then to the second distal end section with the very flexible stinger.

Therefore, Meglin teaches away from amended independent claims 1, 20, 52 and 64 because it does not teach or suggest circumferential slits of claims 1, 20, 52 and 64.

Thus, because Meglin does not teach or suggest every feature of independent claims 1, 20, 52 and 64, (in addition to failing to teach or suggest every element of dependent claims 19 and 21) applicants respectfully submit that the anticipation rejection based upon Meglin is improper and should be withdrawn.

With respect to the rejection based upon Swanson, applicants respectfully submit that this rejection is improper as Swanson, like Meglin fails to teach or suggest circumferential slits. Swanson only teaches eye-shaped openings or perforations that extend longitudinally or axially along the tube, not circumferentially.

Further, the patent office relies upon Fig. 3 of Swanson which discloses a guide wire tube 110 with spaced perforations only. The perforations shown in Fig. 3 are not the same as the claimed slits. Specifically, a slit is defined by Webster Ninth

Collegiate Dictionary as being a "long narrow, cut or opening." The openings of Swanson are large eye-shaped perforations shown in Fig. 3 (and for that matter, Figs. 1 and 2) and therefore do not satisfy the circumferentially extending slit elements of independent claims 1, 20, 52 and 64. As a result, the anticipation rejections based upon Swanson is improper and should be withdrawn.

Applicants also note that on page 4, paragraph 3 the Patent Office repeats an anticipation rejection based upon Swanson. However, based upon the Patent Office's description of the reference relied upon, it is apparent that the Patent Office is rejecting all claims based upon U.S. Patent No. 6,592,659 ("Bigus"). If applicants are incorrect in this regard, an early notification from the examiner is solicited.

In any event, Bigus, like Meglin and Swanson, does not teach or suggest the circumferentially extending slits required by independent claims 1, 20, 52 and 64 and therefore the anticipation rejection based upon Bigus is improper should be withdrawn.

Further, Bigus is directed toward a protective sheath for a catheter. Bigus is not directed toward a hypotube but, instead, discloses an opening 22 in the distal end thereof through which the stent 32 may be extended. Alternatives include a tapered end 18 with either an axial slit 50 or axial perforations 52 through which a balloon catheter and stent may be forced through. See column 8, lines 49-67. Bigus' axial slit 50 or axial perforations 52 have nothing to do with hypotube flexibility.

In contrast, the pending claims are directed toward hypotubes which form the proximal end of the balloon catheter apparatus, not the distal end as disclosed in Bigus.

Thus, Bigus fails to teach or suggest circumferential slits, and therefore applicants respectfully submit that the anticipation rejection based upon Bigus is improper and should be withdrawn.

Finally, all claims stand rejected as being anticipated by Bagaoisan. Applicants respectfully submit that the anticipation rejection based upon Bagaoisan is improper for the same reasons as set forth above in connection with the other references. Specifically, Bagaoisan merely teaches perforations 47 and in no way teaches or suggests circumferential slits. Thus, Bagaoisan does not teach or suggest every element of the pending independent claims in the anticipation rejection is improper.

Thus, because Bagaoisan fails to teach or suggest circumferential slits, applicants respectfully submit that the anticipation rejection based upon Bagaoisan is improper and should be withdrawn.

Having all prior art rejections been traversed, applicants respectfully submit that this application is in a condition for allowance in an early action so indicating is respectfully requested. Applicants also respectfully re-solicit the reconsideration of all withdrawn dependent apparatus claims for the reasons set forth above.


The Commissioner is authorized to charge any fee deficiency required by this paper, or credit any overpayment, to Deposit Account No. 13-2855.

Respectfully submitted,

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By:



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